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08/756013

APPLICATION NUMBER 08/756013 FILING DATE 11/25/96 SEEN FIRST NAMED APPLICANT B INVENTOR'S NAME 117-2294002

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18M1/1002

EXAMINER

GAMBEL, P

ART UNIT PAPER NUMBER

1806

6

DATE MAILED: 10/02/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on _____

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-23 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) 1-23 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Serial No. 08/756018
Art Unit 1806

1. The Art Unit location and the examiner of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1806.
2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-9, drawn to organic molecules, classified in Class 530, subclass 391.1. and 530, subclass 350.
 - II. Claims 10-14, drawn to nucleic acid encoding organic molecules and associated vector and host cells, classified in Class 435, subclass 172.2 and 320.1 and Class 536, subclass 23.1.
 - III. Claims 15-16, drawn to methods of inhibiting P-selecting binding with organic molecules, classified in Class 436, subclass 501.
 - IV. Claims 17-23, drawn to method of reducing inflammation or reducing/protecting extravasation-dependent adverse reactions, classified in Class 424, subclass 130.1 or Class 514, subclass 8.
3. Inventions I and III/IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as affinity purification procedures or detection assays.
4. Inventions III and IV are different methods of use. These inventions require different ingredients, process steps and endpoints to accomplish the use of organic molecules. Therefore they are novel and unobvious in view of each other and are patentably distinct.
5. Inventions I and II are different products. The organic molecules of Invention I and the nucleic acid, host cells and vectors of Invention II are distinct because their structures and modes of action are different. Therefore they are novel and unobvious in view of each other and are patentably distinct.
6. Inventions II and III/IV are not related as products and a method of use. Therefore, they are novel and unobvious in view of each other and are patentably distinct.

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7. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the organic molecules can be made by non-recombinant means.

8. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-IV is not required for any other group from Groups I-IV and Groups I-IV have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

9. This application contains claims directed to the following patentably distinct species of the claimed invention I/II/III/IV: wherein the organic molecule comprises:

- A) AGP or
- B) antibody.

These species are distinct because their structures and modes of action are different.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 10, 15, 17 and 18 are generic.

10. If Invention IV is elected, then the following species election is required.

This application contains claims directed to the following patentably distinct species of the claimed invention IV: wherein the inflammation or extravasation-dependent organ or adverse immune reaction is a result of

- A) clotting ,
- B) a microbial factor,
- C) a host factor (e.g. autoimmunity)
- D) septic shock or septicemia..

These species are distinct because the pathological conditions differ in etiologies and therapeutic endpoints. Species B and D may be rejoined, if applicant considers B to be drawn to septic shock and septicemia. If B and D are different therapeutic endpoints, then the species election stands.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17, 18 and 20 are generic.

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11. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

12. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee can be reached on (703) 308-2731. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014 or (703) 308-4242.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[lila.feisee@uspto.gov\]](mailto:lila.feisee@uspto.gov).

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Phillip Gambel, PhD.
Patent Examiner
Group 1800
September 30, 1997

